



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Matters Related to Patent Appeals

ACTION: Proposed collection; comment request.

SUMMARY: The United States Patent and Trademark Office (USPTO), as part of its continuing effort to reduce paperwork and respondent burden, invites the general public and other Federal agencies to take this opportunity to comment on this new information collection, as required by the Paperwork Reduction Act of 1995, Public Law 104-13 (44 U.S.C. § 3506(c)(2)(A)).

DATES: Written comments must be submitted on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: You may submit comments by any of the following methods:

- E-mail: InformationCollection@uspto.gov. Include "0651-00xx Matters Related to Patent Appeals comment" in the subject line of the message.
- Mail: Susan K. Fawcett, Records Officer, Office of the Chief Information Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.
- Federal Rulemaking Portal: <http://www.regulations.gov>.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Raul Tamayo, Legal Advisor, Office of Patent Legal Administration, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-7728; or by e-mail to Raul.Tamayo@uspto.gov.

Additional information about this collection is also available at <http://www.reginfo.gov> under "Information Collection Review."

SUPPLEMENTARY INFORMATION

I. Abstract

During its examination of an application for patent or for reissue of a patent, or during its reexamination of a patent, the United States Patent and Trademark Office

(USPTO) makes many decisions of a substantive nature which the applicant or patent owner may feel deny him or her the patent protection to which he or she is entitled. Where the differences of opinion on such matters concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and a procedure for appealing to the Board of Patent Appeals and Interferences has long been provided by statute (35 U.S.C. § 134).

Applicants and patent owners initiate the appeal procedure by filing a Notice of Appeal. At the time of filing a Notice of Appeal, applicants and patent owners may request that a panel of examiners formally review the legal and factual basis of the rejections in their application prior to the filing of an Appeal Brief, by filing a Pre-Appeal Brief Request for Review. In addition, applicants and patent owners who desire an oral hearing before the Board may request the hearing by filing a Request for Oral Hearing Before the Board of Patent Appeals and Interferences.

Currently, Notices of Appeal, Requests for Oral Hearing, and Pre-appeal Brief Requests for Review are covered under 0651-0031 Patent Processing (Updating). The USPTO has determined that it would be beneficial to transfer

these items out of 0651-0031 and into their own collection. Therefore, the USPTO is requesting the creation of a new collection which will transfer the three existing notices and requests out of the 0651-0031 inventory into a new collection of information titled "Matters Related to Patent Appeals". For a complete listing of the items covered by this collection, please see the table in Section III of this notice.

The information in this collection can be submitted electronically through EFS-Web, the USPTO's web-based electronic filing system, as well as on paper. The USPTO is taking this opportunity to account for the electronic submissions in this collection.

There are forms associated with the Notices of Appeal (PTO/SB/31), the Requests for Oral Hearing Before the Board of Patent Appeals and Interferences (PTO/SB/32), and the Pre-appeal Brief Requests for Review (PTO/SB/33). Therefore, after approval, this collection will have three forms.

II. Method of Collection

By mail, facsimile, or hand delivery to the USPTO when an applicant files the various notices or requests. The remaining papers can also be filed as attachments through

EFS-Web.

III. Data

OMB Number: 0651-00xx.

Form Number(s): PTO/SB/31/32/33.

Type of Review: New information collection.

Affected Public: Businesses or other for-profits; and not-for-profit institutions.

Estimated Number of Respondents: 54,500 responses per year, with an estimated 10,940 submitted by small entities. Of the total responses, the USPTO expects that 50,700 will be submitted through EFS-Web.

Estimated Time Per Response: The USPTO estimates that it will take the public approximately 12 minutes (0.20 hours) to complete the information in this collection, with the exception of the Pre-appeal Brief Requests for Review, which the USPTO estimates will take approximately 5 hours to complete. These estimated times include gathering the necessary information, creating the documents, and submitting the completed request to the USPTO. The USPTO calculates that, on balance, it takes the same amount of time to gather the necessary information, create the document, and submit it to the USPTO, whether the applicant submits the information in paper form or electronically.

Estimated Total Annual Respondent Burden Hours: 86,740 hours.

Estimated Total Annual Respondent Cost Burden: \$29,491,600. The USPTO estimates that attorneys will complete the items in this collection. Using the professional hourly rate of \$340 for attorneys in private firms, the USPTO estimates \$29,491,600 per year for the respondent cost burden for this collection.

Item	Estimated time for response	Estimated annual responses	Estimated annual burden hours
Notice of Appeal	12 minutes	2,600	520
Electronic Notice of Appeal	12 minutes	34,900	6,980
Request for Oral Hearing Before the Board of Patent Appeals and Interferences	12 minutes	100	20
Electronic Request for Oral Hearing Before the Board of Patent Appeals and Interferences	12 minutes	1,100	220
Pre-Appeal Brief Request for Review	5 hours	1,100	5,500
Electronic Pre-Appeal Brief Request for Review	5 hours	14,700	73,500
Totals	-----	54,500	86,740

Estimated Total Annual Non-hour Respondent Cost Burden: \$22,266,670. This collection has annual (non-hour) costs in the form of filing fees and postage costs.

The USPTO estimates that this collection will have a total annual cost of \$22,264,200 in filing fees.

Item	Responses (a)	Filing Fees (b)	Total Cost (a) x (b) (c)
Notice of Appeal	2,100	\$620.00	\$1,302,000.00

Item	Responses (a)	Filing Fees (b)	Total Cost (a) x (b) (c)
Notice of Appeal (small entity)	500	\$310.00	\$155,000.00
Electronic Notice of Appeal	27,900	\$620.00	\$17,298,000.00
Electronic Notice of Appeal (small entity)	7,000	\$310.00	\$2,170,000.00
Request for an Oral Hearing	60	\$1,240.00	\$74,400.00
Request for an Oral Hearing (small entity)	40	\$620.00	\$24,800.00
Electronic Request for an Oral Hearing	900	\$1,240.00	1,116,000.00
Electronic Request for an Oral Hearing (small entity)	200	\$620.00	\$124,000.00
Pre-Appeal Brief Request for Review	900	None	\$0.00
Pre-Appeal Brief Request for Review (small entity)	200	None	\$0.00
Electronic Pre-Appeal Brief Request for Review	11,700	None	\$0.00
Electronic Pre-Appeal Brief Request for Review (small entity)	3,000	None	\$0.00
Totals	54,500	-----	\$22,264,200.00

The public may submit the notices and requests in this collection to the USPTO by mail through the United States Postal Service. All correspondence may include a certificate of mailing for each piece of correspondence enclosed, stating the date of deposit or transmission to the USPTO in order to receive credit for timely filing. The USPTO has estimated that the vast majority of these submissions will weigh no more than two ounces. Therefore, the USPTO is conservatively estimating that these submissions will be mailed by first-class postage at 65 cents. Postage for the certificates of mailing themselves are not calculated into this estimate as they are included

with the individual pieces of correspondence that are being deposited with the United States Postal Service.

The USPTO estimates that 3,800 responses will be mailed by first-class postage, for a total annual cost of \$2,470 in postage costs.

Item	Responses (a)	Postage Costs (b)	Total Cost (a) x (b) (c)
Notice of Appeal	2,600	0.65	\$1,690.00
Request for Oral Hearing Before the Board of Patent Appeals and Interferences	100	0.65	\$65.00
Pre-Appeal Brief Request for Review	1,100	0.65	\$715.00
Totals	3,800	-----	\$2,470.00

The total annual (non-hour) respondent cost burden for this collection in the form of filing fees and postage costs is estimated to be \$22,266,670 per year.

IV. Request for Comments

Comments are invited on: (a) whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility; (b) the accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information; (c) ways to enhance the quality, utility, and clarity of the information to be collected; and (d) ways to minimize the burden of the collection of information on

respondents, e.g., the use of automated collection techniques or other forms of information technology.

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection; they also will become a matter of public record.

Dated: December 29, 2011

Susan K. Fawcett,
Records Officer, USPTO,
Office of the Chief Information Officer
[FR Doc. 12-XXXXX, Filed XX-XX-12; 8:45 am]
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